

### **REMARKS**

Claims 1, 10, 11, and 18 are amended. Claims 16-17 and 19-20 are canceled. Claims 21-22 are new.

Claim 1 is amended to disclose, *inter alia*, detecting an installation of a portable computer-readable media device; prompting a user for a network name; writing an XML settings file, an autorun file, and a network setup application to the portable computer-readable media device; and reading an XML device configuration file after the re-installation of the portable computer-readable media device. Support for the amendments to claim 1 may be found, for example, in the specification at [0047] and [0050]-[0056], and in Figure 3, reference 311.

Claim 10 is amended to disclose analyzing the XML device configuration file to determine if any faults occurred during a provisioning of a network device. Support for these amendments may be found, for example, in the specification at [0047], [0050], [0051] and [0052], and in Figure 3, reference 311.

Claim 11 is amended to clarify antecedent basis and to move a limitation from the preamble into the body of the claim. Claim 11 is further amended to include an XML device configuration file, stored on the portable computer-readable media, corresponding to an electronic device. Support for these amendments may be found, for instance, in the specification at [0008], [0041]-[0042], [0047], [0050]-[0052] and [0055], and in Figure 3.

Claim 18 is amended to disclose detecting an autorun file on the portable computer-readable media device, and automatically uploading a configuration based on detecting the auto-run file. Claim 18 is also amended to clarify antecedent basis, and to include generating an XML device configuration file and writing the XML device configuration file to the portable computer-readable media device. Support for these amendments may be found, for example, in the specification at [0042], [0047], [0050]-[0052] and [0055], and in Figure 3.

Claims 21 and 22 are new. Support for claims 21 and 22 may be found, for example, in the specification at [0047], [0050]-[0052], [0055] and [0056] and Figure 3.

Claim Rejections Under 35 USC §103(a)

Claims 1-5, 7-11, 13-15 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over *King et al.*, US Publication No. 2002/0087868 (hereinafter “King”) in view of *Das*, US Patent No. 7,013, 331 (hereinafter “Das”). Accordingly, Applicants have amended claims 1, 10, 11 and 18, and respectfully submit that claims 1-5, 7-11, 13-15 and 18 are allowable over King in view of Das, for at least the reasons discussed below.

**King:**

King is generally directed to replacing a defective unit with a replacement unit in a data communications network (King, [0053]). A smart card, containing the network ID and configuration of the defective unit, is inserted into the replacement unit, and the replacement unit begins a boot process. During the boot process of the replacement unit, the network identification and configuration of the defective unit are obtained from the smart card and are used to configure the replacement unit so that it connects and appears to the network as the original, defective unit (King, [0059]-[0062]).

**Claim 1:**

Applicants respectfully submit that amended independent claim 1 is non-obvious over King in view of Das. As stated by M.P.E.P. §2143, a *prima facie* case of obviousness for amended claim 1 requires each and every element of claim 1 to be found in a combination of cited prior art:

To reject a claim based on this rationale...Office personnel must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference...

Applicants respectfully submit that each element of amended independent claim 1 is not found in a combination of King and Das.

## INSTALLATION

For example, King does not appear to teach, suggest or disclose the element from claim 1 “detecting an installation of a portable computer-readable media device.” King only teaches detecting the *presence* of a smart card during a boot process of his replacement device (King, Figs 5, 6 and 8), and not its *installation* (i.e., the change of state from an absence of the smart card to its presence). As the smart card must be inserted before the booting of the replacement device, the replacement device is not booted up at the time of installation of the smart card. The pre-boot replacement unit is not live at the time of smart card installation, and therefore cannot detect the installation of the smart card or the installation of anything else, for that matter. King merely discloses the replacement device looking for the presence of the smart card during its boot sequence.

Even if a smart card is inserted into King’s replacement device after the boot process, King teaches that the replacement unit must be again manually re-booted in order to detect the presence of the smart card: “the processing unit operating without a smart card is configured to raise an alarm via the network to indicate that it requires user servicing to... insert a smart card and reboot the processing unit...” (King, [0067]). Thus, again, King’s invention merely teaches detecting the presence of the smart card during the boot process, and not its installation.

Amended claim 1, however, calls for the detection of an *installation* of a portable computer-readable media device, that is, detection of the change of state from an absence of the portable computer-readable media device to its presence. At any time, even when a computing device is past the boot stage, claim 1 recites the detection of the installation of a portable computer-readable media device. No boot is required.

## AUTORUN FILE

Furthermore, King also does not appear to teach, suggest or disclose the element from claim 1 “writing the XML settings file, an autorun file, and a network setup application to the portable computer-readable media device.” In fact, King has no need for an autorun file or a network setup application on the smart card. During the boot sequence, King’s processor reads instructions from the boot PROM 48 to determine the presence of a smart card, and then accesses the smart card for needed information (King, [0060]). Thus, King’s processor,

not the smart card, triggers the access of configuration information on the smart card to set up the network settings. An autorun file and network setup application on the smart card are not necessary in King.

#### REPORT FILE

Moreover, King does not appear to teach, disclose or suggest the element of claim 1: “reading, from the portable computer-readable media device after a re-installation of the portable computer-readable device, an XML report file including an applied configuration of the network device.” King is generally directed to using the smart card to apply a configuration to the defective device, and not as a feedback and/or reporting mechanism for the results.

This distinction makes sense, as King is generally directed to configuring a replacement for a defective device in a network. King’s smart card may be inserted into the replacement so that upon booting the replacement, network configuration information may be read and quickly applied to minimize perceived down-time of the defective node. The replacement device is a direct substitution for the defective device, and appears so to the network.

The present application provides significant benefit over King. The present application is generally directed to configuring new, additional electronic devices into the network, not replacement devices. The present application does not require a boot of each new network electronic device in order for network settings to be applied. Rather, at any time, even while live, a portable computer-readable media device may be inserted into a new (to the network) electronic device and prompt the new device to apply network settings. A shut-down and/or re-boot of the new device is not necessary, thus saving time and providing convenience.

Moreover, with the present application, a portable computer-readable media device may be used as a reporting and feedback mechanism on the provisioning of devices. Each time the portable computer-readable media device is used to configure a network device, a record of the applied configuration of the network device and any faults may be maintained on the portable computer-readable media device. The records may then be saved and/or analyzed.

To illustrate the benefits of the present application, consider a scenario of a person traveling to attend an industry conference with his/her laptop. In order to connect with the conference's network, s/he does not need to reboot in order to gain access, as required by King. With the claimed material, s/he merely may insert, for example, a memory stick into his/her computer. The memory stick may contain a configuration file for connecting to the conference's network, and may prompt the attendee's computer to automatically apply the network settings. S/he is not required to reboot in order to access the conference's network. Furthermore, a single memory stick may be shared amongst multiple attendees of the conference. After all attendees' laptops have been configured, the conference IT administrator may retrieve the memory stick, view the device configuration files for each attendee, and debug any faulty configurations. The data of the device configuration files may also be useful for the conference IT administrator for aggregating network connection information across various, different types of computing devices.

Of course, this is only one scenario used to illustrate the benefits of the present application, and is not comprehensive of every possible embodiment of the present application.

Das also does not appear to teach the missing elements. In fact, Das appears to be silent on the presence of any type of portable computer-readable media devices, let alone detecting an installation of a portable computer-readable media device, or reading an XML device configuration file from the portable computer-readable media device after its re-installation.

For at least these reasons, Applicants respectfully submit that no combination of the disclosures of King and Das could be combined to produce each and every element recited in amended independent claim 1. Amended independent claim 1 is therefore non-obvious over King and Das, and allowable over King and Das under 35 USC §103(a).

#### **Claims 2-5 and 7-10:**

Claims 2-5 and 7-10 each depend from independent claim 1. 35 U.S.C. §112, ¶4 states that "A claim in dependent form ... specif[ies] a further limitation ... [and] shall be construed to incorporate by reference all the limitations of the claim to which it refers."

Thus, each of claims 2-5 and 7-10 incorporate by reference all limitations of independent claim 1. Applicants submit that for reasons similar to claim 1, each of claims 2-5 and 7-10 is also non-obvious over King and Das.

Furthermore, with regard to claim 5, the Office Action cited to page 4, [0039] of Cedola as teaching an element of claim 5. Cedola was cited in PTO-892 on September 13, 2007. Cedola, however, does not preclude patentability of the present application, as previously discussed in the Amendment in Response to Non-Final Action dated November 13, 2007. Thus, the Office Action has not shown a combination of prior art references that teach, suggest or disclose each and every element of claim 5.

For at least the above reasons, Applicants respectfully submit each of claims 2-5 and 7-10 are allowable under 35 USC §103(a).

#### **Claim 11:**

Applicants respectfully submit that amended claim 11 is non-obvious over King in view of Das. As stated by M.P.E.P. §2143, a *prima facie* case of obviousness for amended claim 11 requires each and every element of claim 11 to be found in a combination of cited prior art:

To reject a claim based on this rationale...Office personnel must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference...

Applicants respectfully submit that each element of claim 11 is not found in a combination of King and Das. For example, neither King nor Das appears to teach, suggest or disclose the element from claim 11 “an autorun file stored on the portable computer-readable media device for prompting the electronic device to automatically apply the network settings configuration,” as discussed below.

#### **AUTORUN FILE**

King does not appear to teach automatically applying the network settings configuration based on the prompting of an autorun file. Instead, King teaches that the

electronic device or computer processor applies network settings based on the execution of the boot process on the computer itself:

...the processor 42 on the motherboard 24 reads instructions from the boot PROM 48. In accordance with these instructions the processor 42 operates to interrogate the smart card reader 40 via the 12C bus 44 to ascertain whether or not a smart card is present in the smart card reader 40. If the smart card is present, the processor 42 operates to read the network identity from the smart card 54 and to configure the communications port 50 with this network identity... (King, [0060])

Thus, King requires a boot process to be executed at the computer before the smart card may be accessed and its configuration information applied to the computer. Contrary to claim 11, King does not teach an autorun file on the smart card prompting the processor to apply the network setting.

Furthermore, as discussed for claim 1, King does not appear to describe an XML device configuration file on the portable computer-readable media device for providing provisioning results and status, as recited in claim 11:

an XML device configuration file stored on the portable computer-readable media device after a provisioning of the electronic device, the XML device configuration file corresponding to the electronic device and containing a provisioned network settings configuration of the electronic device and an indication of any faults that occurred during the provisioning of the electronic device with the provisioned network settings configuration.

King is generally directed to using the smart card to apply a configuration to the defective device, and not using the smart card as a feedback and/or reporting mechanism for the configuring or provisioning results.

This distinction makes sense, as King is generally directed to configuring a replacement for a defective device in a network. King's smart card may be inserted into the replacement so that upon booting the replacement, network configuration information may be read and quickly applied to minimize perceived down-time of the defective node.

The present application, however, is directed to configuring new, additional electronic devices into the network, not replacement devices. The present application does not require a

boot of each new network electronic device in order for network settings to be applied. Rather, at any time, even while live, a portable computer-readable media may be inserted into a new (to the network) electronic device and prompt the new device to apply network settings. A shut-down and/or re-boot of the new device is not necessary, thus saving time and providing convenience. The present application also provides, on the portable computer-readable media device, useful data from the configuring process. The XML device configuration file of claim 11 thus provide feedback and data from the provisioning process and any generated errors or faults. King simply does not provide this novel element.

Das also does not appear to teach the missing element of claim 11. In fact, Das appears to be silent on the presence of any type of portable computer-readable media devices, let alone a portable computer-readable media device having an autorun file to prompt an electronic device to apply network settings. Indeed, the Office Action did not refer to Das as teaching any part of claim 11.

Therefore, for at least these reasons, Applicants respectfully submit that no combination of the disclosures of King and Das could be combined to produce each and every element recited in amended independent claim 11, and thus, amended independent claim 11 is non-obvious over King and Das. Amended claim 11 is therefore allowable over King and Das under 35 USC §103(a).

#### **Claims 13-15:**

Claims 13-15 each depend from independent claim 11. 35 U.S.C. §112, ¶4 states that "A claim in dependent form ... specif[ies] a further limitation ... [and] shall be construed to incorporate by reference all the limitations of the claim to which it refers." Thus, each of claims 13-15 incorporate by reference all limitations of independent claim 11. Applicants submit that for reasons similar to claim 11, each of claims 13-15 is also non-obvious over King and Das. Therefore, claims 13-15 are each allowable over King and Das under 35 USC §103(a).

#### **Claim 18:**

Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness for claim 18 by King in view of Das. As stated by M.P.E.P. §2143, in



order to establish a *prima facie* case of obviousness for claim 18, the Office Action to show that each and every element of claim 18 to be found in a combination of cited prior art:

To reject a claim based on this rationale...Office personnel must articulate the following:

(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference...

The Office Action cited stated on page 2, item 5 that independent claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Das. However, the Office Action did not articulate any specific findings in King or in Das that teach, suggest or disclose any element of claim 18. Merely stating that a claim is unpatentable under 35 U.S.C. 103(a) does not make it so; specific rationale must be articulated.

Moreover, for reasons similar to independent claim 11, Applicants submit that neither King nor Das discloses each and every element of amended independent claim 18. For example, for reasons similar to claim 11, Applicants submit that neither King nor Das teaches, discloses or suggests at least the elements from claim 18: “detecting an autorun file on the portable computer-readable media device,” “based on the step of detecting the autorun file, automatically uploading a configuration from the portable computer-readable media device...,” “generating an XML device configuration file...,” or “writing the XML device configuration file to the portable computer-readable media device.”

Accordingly, for at least the above reasons, Applicants submit that no combination of the disclosures of King and Das could be combined to produce each and every element recited in amended independent claim 18, and that the Office Action has not established a *prima facie* case of obviousness for claim 18 by King in view of Das. Therefore, amended independent claim 18 is non-obvious over King and Das and allowable over King and Das under 35 USC §103(a).

#### **Claims 6 and 12:**

Claims 6 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Das and in further view of *Polcha, et al.*, US Publication No. 2003/0217126 (hereinafter “Polcha”).

Claim 6 depends from independent claim 1, and claim 12 depends from independent claim 11. Thus, claim 6 incorporates by reference each and every element of independent claim 1, and claim 12 incorporates by reference each and every element of independent claim 11. For reasons similar to claims 1 and 11, Applicants respectfully submit that no alleged combination of the disclosures of King and Das could be combined to produce each and every element of claim 6 and claim 12. For example, as previously discussed, no combination of King and Das could be combined to describe the element from claim 1 incorporated by reference into claim 6: “reading, from the portable computer-readable media device after a re-installation of the portable computer-readable media device, an XML device configuration file including an applied configuration of the network device” Also as previously discussed, no combination of King and Das could be combined to describe the element from claim 11 incorporated by reference into claim 12:

an XML device configuration file stored on the portable computer-readable media device after a provisioning of the electronic device, the XML device configuration file corresponding to the electronic device and containing a provisioned network settings configuration of the electronic device and an indication of any faults that occurred during the provisioning of the electronic device with the provisioned network settings configuration.

Polcha [0123]-[0124] only describes a configuration and a dialer program to be stored on a USB key-type memory device, but neither the dialer program nor the configuration program correspond to the XML device configuration file of claims 1 and 11. The dialer program is an application that merely performs dialing functions such as login/password functions (Polcha, [0114], [0123]). The configuration program is an executable that automatically updates a remote computer’s configuration settings (Polcha, abstract), however, Polcha [0124] teaches the deletion of the configuration program after it has finished running: “Additionally, according to the preferred embodiment, the executable configuration file is self deleting. That is, upon execution on the remote computer, after the remote computer is fully configured the executable file is automatically deleted...”

Thus, Polcha does not appear to teach, disclose or suggest “reading, from the portable computer-readable media device after a re-installation of the portable computer-readable media device, an XML device configuration file including an applied configuration of the

network device,” as recited in claim 1. Polcha also does not appear to teach, disclose or suggest

an XML device configuration file stored on the portable computer-readable media device after a provisioning of the electronic device, the XML device configuration file corresponding to the electronic device and containing a provisioned network settings configuration of the electronic device and an indication of any faults that occurred during the provisioning of the electronic device with the provisioned network settings configuration,

as recited in claim 11.

For at least the above reasons, Applicants submit no alleged combination of elements in King, in view of Das, in further view of Polcha could produce each and every element of claims 1 and 11, and, therefore, no alleged combination of elements in King, in view of Das, in further view of Polcha could produce each and every element of dependent claims 6 and 12. Therefore, a *prima facie* case of obviousness cannot be established for claims 6 and 12 with respect to King, in view of Das, and in further view of Polcha. Accordingly, claims 6 and 12 are non-obvious over King, Das and Polcha and are allowable over King, Das and Polcha under 35 USC §103(a).

### **CONCLUSION**

In view of the above amendments and arguments, the Applicants submit the pending application is in condition for allowance and an early action so indicating is respectfully requested.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855, under Order No. 30835/306004, from which the undersigned is authorized to draw.

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Respectfully submitted,

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